

RECEIVED
CENTRAL FAX CENTER

APR 23 2007

CITI0219-US
Serial No. 09/832,863

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Arun AHUJA, et al.

Art Unit: 2154

Serial No.: 09/832,863

Examiner: PATEL, Ashokkumar

Filed: April 12, 2001

For: METHOD AND SYSTEM FOR NOTIFYING CUSTOMERS OF
TRANSACTION OPPORTUNITIES

BY FACSIMILE - 571-273-8300

U.S. Patent and Trademark Office
Customer Service Window, Mail Stop AF
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Pre-Appeal Brief Request for Review

Sir: The following is intended to be in compliance with the pilot program guidelines set forth in the July 12, 2005 OG Notice and is submitted with a Notice of Appeal. The undersigned respectfully requests careful consideration of the errors identified herein.

The outstanding rejections of claims 1-23 are as follows:

(a) Claims 1-3, 5-17 and 19-23 under 35 USC 102(e) as being anticipated by Langseth (6,654,316); and

(b) Claims 4 and 18 under 35 USC 103(a) as being unpatentable over Langseth in view of Rajan (6,633,910).

APR 23 2007

CITI0219-US

PATENT

Serial No. 09/132,863

Rejection of Claims 1-3, 5-17 and 19-23 in View of Langseth

For each of the independent claims 1, 7, 8, 19 and 23, the undersigned submits that the following limitations listed for each claim are not disclosed in Langseth and thus Langseth cannot anticipate claims 1-23 as suggested by the Office.

In claims 1 and 23:

- determining a status of the customer as a member customer or a non-member customer of an institution providing the notification system
- prompting the customer to select at least one requested event, wherein a member customer is provided with more event choices than a non-member customer

In claim 7:

- means for determining a status of the customer as a member customer or a non-member customer of an institution providing the notification system
- means for prompting the customer to select at least one requested event, wherein the member customer is provided with more event choices than the non-member customer

The undersigned submits that the Office's arguments highlight the misinterpretation of the reference and the claims. Langseth discloses a generic notification system to which subscribers may subscribe to receive notification services. More specific entities, e.g., affiliates such as financial institutions, communications companies, Internet companies or the like, may be used to pass the notification information generated by the generic notification system to subscribers who are also customers of the affiliates or to act merely as referral sources for the generic notification system. (See Col. 9, lines 42-44). In order to receive notifications offered by the generic notification system, all subscribers are necessarily customers/subscribers to the generic notification system. Subsets of the customers/subscribers may also be customers of affiliates. The information that the affiliates provide to their customers may be different from that provided by the generic notification system, but this determination is made by the affiliate, not the generic notification system. Accordingly, the generic notification system does not make any determination regarding member and non-member customers. Similarly, the affiliates do not distinguish between member and non-member customers as they deal only with their own customers. Using the example in Langseth, in order to anticipate claims 1, 7 and 23 of the present application, the generic notification system would need to distinguish between member and non-member customers --- which it does not do. And further, the generic notification system would need to provide fewer choices to non-member (as compared to member) customers --- which it does not do.

With respect to claims 1, 7 and 23, the Office suggests that member customers are, "a subscriber or any individual or entity that signs up to receive a service;" the services being exemplified in col. 3, line 59 to col. 4, line 10 of Langseth. (See Page 3 of Final Office Action). And the Office argues that non-member customers are "affiliate and affiliate's customers" referring to col. 4, line 31-21(?) and col. 9, line 36-39. The undersigned has reviewed these cited sections numerous times and simply fails to see how these sections demarcate member customers

CITI0219-US

PATENT

Serial No. 09/132,863

from non-member customers of an institution providing the notification system. Langseth does teach that third party affiliates may be used to refer customers to the subscription service, but these "referred customers" are incorrectly defined by the Office as non-member customers. These "referred customers" are provided with as many event choices as direct subscribers to the generic subscription service. In fact, referring to the subscription process for the "referred customers" which is described with respect to Figure 18, it is clear from Step 904 that the "referred customers" go through the same subscription process with the subscription service as the direct subscribers (see Figure 3). Additionally, if anything, the "referred customers" may have access to additional services not offered by the subscription service to the direct subscribers. Such services being add-ons offered by the referring affiliates to their customers.

The Office also refers to Col. 25, line 59 through Col. 26, line 35 as disclosing how services are defined through the affiliates. The undersigned has reviewed these portions of Langseth, but fails to see how this disclosure anticipates the identified limitations in claims 1 and 7. At most, these paragraphs in Langseth describe how the affiliates interact with their customers. There is no status determination between member and non-member customers. Nor is there prompting of the customer to select an event, wherein member customers have more event choices than non-member customers.

In claim 8:

- a database containing financial information, wherein the financial information is collected from at least one internal source and at least one external source
- a database for generating a notification report at the customer's request, wherein the notification report includes at least data describing each notification message sent to the customer during a customer selected period of time

The Office maintains that Langseth discloses "a database containing financial information, wherein the financial information is collected from at least one internal source and at least one external source" since an affiliate financial institution may provide financial information to an information source channel database. The undersigned agrees that this qualifies as financial information from an **external source**. Where Langseth is lacking is the disclosure of **financial information from an internal source**. It is not at all surprising that this teaching would be lacking since the generic notification system is not itself a source of financial information since it is not a financial institution. The Office attempts to argue that the phrase "other informational and/or transaction data" equates to financial information from an internal source, but this argument clearly fails since Langseth does not describe this data as being financial data.

The Office submits that periodic billing equates to "a database for generating a notification report at the customer's request, wherein the notification report includes at least data describing each notification message sent to the customer during a customer selected period of time." With all due respect, periodic billing by the subscription service is not the same as generation of customer requested reports describing notification messages sent within a customer

CITI0219-US

PATENT

Serial No. 09/32,863

selected time period. Similarly, the reference to report generation cited on Page 9 of the Final Office Action also does not even come remotely close to disclosing the claimed limitation.

In claims 19 and 23:

-receiving financial information into a second database of the notification system, wherein the incoming financial information is received into the second database from at least one outside source and at least one inside source, and further wherein the incoming financial information received from the at least one inside source results from a change in at least one customer account maintained by the host financial institution

The Office's arguments with respect to the limitation "receiving financial information into a second database of the notification system, wherein the incoming financial information is received into the second database from at least one outside source and at least one inside source, and further wherein the incoming financial information received from the at least one inside source results from a change in at least one customer account maintained by the host financial institution" track those recited with respect to claim 8. Namely, the Office points to the section of Langseth that describes the population of data channels with financial information by an affiliate financial institution.

Again, while the undersigned admits that this is an example of an outside source of financial information, no inside source of financial information has been described. Further, the host of the notification system is never described in Langseth as being a financial institution. At most, an affiliate is a financial institution. The host of the generic notification system is never described in Langseth as being associated with any particular industry other than through affiliates and thus would not be the source for industry specific information, e.g., financial, product, etc.

The undersigned submits that claims 4 and 18 are allowable for the reasons stated above with respect to independent claims 1 and 8. In view of the remarks stated above, the undersigned representative respectfully requests that the rejections of claims 1-23 be withdrawn and a notice of allowance is earnestly solicited.

Respectfully submitted,

Date: April 23, 2007
KILPATRICK STOCKTON LLP
Suite 900
607 14th Street, N.W.
Washington, D.C. 20005
(202) 508-5889

By: /Dawn-Marie Bey - #44,442/
Dawn-Marie Bey
Registration No. 44,442